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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/760,179
Filing Date: January 16, 2004
Appellant(s): ALCINI ET AL.

Gordon K. Harris, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 12, 2007 appealing from the Office action mailed October 13, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,614,699	Yashiro et al.	3-1997

(9) Related Proceedings Appendix

None.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Yashiro et al. (US 5,614,699).

With respect to claims 1 and 16, Yashiro et al. teach a method and an arrangement of controlling exhaust flow in an exhaust system for a non-conventional internal combustion power source exhibiting, during operation, larger ranges of acoustic frequency, flow rate or pressure in exhaust flow than found in conventional internal combustion power sources (Col.1, Line 59 – Col.3, Line 41), the method comprising placing a passive temperature resistant valve (Fig.8, Item 16) in a path of exhaust gas flow, the valve operative to at least partially alter a characteristic of the exhaust gas flow for the larger ranges (Col.7, Lines 3 – 14).

With respect to claims 2 – 5 and 17 – 20, Yashiro et al. teach wherein the characteristic of the exhaust gas flow comprises at least one of flow restriction, flow reflection and flow direction (Col.2, Lines 1 – 16, 36 – 41 and 47 – 67); and wherein the

passive, temperature resistant valve is placed substantially at a midpoint of the exhaust system (Fig.8, Col.7, Lines 3 – 14).

With respect to claims 6 and 21, Yashiro et al. teach a method and an arrangement of sound control in an exhaust system for an internal in exhaust gas flow during combustion power source exhibiting discontinuities operation (Col.1, Line 59 – Col.3, Line 41), the method comprising placing a passive, temperature resistant valve (Fig.8, Item 16) in a path of exhaust gas flow, the valve operative to al least partially alter restriction of the exhaust gas flow whenever a discontinuity occurs (Col.7, Lines 3 – 14).

With respect to claims 7 – 15 and 22 – 24, Yashiro et al. teach wherein the passive, temperature resistant valve (Fig.8, Item 16) increases restriction of exhaust gas flow whenever a discontinuous predetermined decrease in exhaust gas flow rate occurs (Col.1, Line 59 – Col.3, Line 41 and Col.7, Lines 3 – 14); wherein the passive, temperature resistant valve restricts exhaust gas flow via a valve surface extending substantially perpendicular to a longitudinal axis of exhaust flow (Fig.8); and wherein the valve (Fig.8, Item 16) surface is positioned in a resonator (Fig.8, Items 2 and 4B) having an inlet (Fig.8, Item 9) coupled to an interior conduit extending into the resonator and terminating in the resonator adjacent to the valve surface (Fig.8).

(11) Response to Argument

Responding to appellant's argument that there is no teaching or suggestion to employ the Yashiro et al. exhaust system in a non-conventional internal combustion power source environment. The Examiner still considers, as established in the Office

Action mailed on October 13, 2006, that a preamble is denied the effect of a limitation where the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951). Additionally, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex Parte Masham, 2 USPQ F.2d 1647 (1987). Furthermore, the Appellant failed to positively claim the use of a valve in an exhaust flow system used with non-conventional power sources, since the claimed subject matter described the valve has to be "operative" to work in such environments. The Examiner considers that Yashiro et al. teaches a system that is operative, able or capable of at least partially altering a characteristic of the acoustic frequency, flow rate or pressure of an exhaust system of a non-conventional power source.

Regarding Appellant's argument with respect to claims 3 – 5, 9 – 14 and 18 – 20, the Examiner considers that Figure 8 and Figures 6, 12 and 24 of Yashiro et al. clearly teach placing the valve (16) near or substantially at a midpoint of the exhaust system as described in the claims. Any person with ordinary skill in the art would acknowledge that the abovementioned figures clearly teach the positioning of the valve near or substantially at a midpoint of the exhaust system; and since the drawings are part of the disclosure, the Examiner considers that Yashiro et al. teach the limitations described in the claims.

The Appellant considers that the preamble of the claims should have complete patentable weight in order to further defined the claimed invention, the Appellant support the argument by establishing, based on a series of court decisions, that the preamble is necessary to give life, meaning and vitality to the claims. However, the Examiner considers that the recitation of exhaust system being part of a non-conventional power source is not necessary to give life, meaning and vitality to the recitation of placing a valve in a path of an exhaust flow, and being "operative" to "at least partially alter" a characteristic of the exhaust flow. The Examiner considers that the Yashiro et al. patent anticipates the reasonable broadest interpretation of the claim.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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